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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,617	06/11/2001	Klaus Wanner	P20670	6673

7055 7590 08/09/2002

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EXAMINER

SHAMEEM, GOLAM M

ART UNIT PAPER NUMBER

1626

DATE MAILED: 08/09/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/763,617

**Applicant(s)**

WANNER ET AL.

**Examiner**

Golam M M Shameem

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Status of Claims*

Claims 31-61 are pending in this application.

The Amendment and response filed by applicant in paper No. 10, dated May 24, 2002 has been entered and considered carefully.

Applicant's arguments is fully considered and found persuasive with respect to the rejection of claims 31-61 under 35 U.S.C. §102 (e) over Ognyanov et al. (US Pat No. 6,191,165) and also under 35 USC § 112 second paragraph but are moot in view of the new grounds of rejection. The finality in the last Office action is also moot in view of the new grounds of rejection.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bondinell et al (US Pat No 4,514,414) in view of Sonnewald, U (US Pat No. 4,931,450) and Ali et al CAS 102.

Applicant claims the compounds of formula (I) that are suited as GABA uptake inhibitors.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Bondinell, Sonnewald and Ali are analogous art of the instant claimed invention being monocyclic amine compounds with GABA uptake inhibitory activity.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Bondinell disclosed structural similar compounds of the claims wherein a pyrrolidinyl compound is substituted with the same  $N-A^2Z$  and  $A^1X$  on the pyrrolidine ring. The difference between the instant claims and Bondinell is that instead of 2-  $A^1X$ , Bondinell has a 3-  $A^1X$  i.e. position isomers. Sonnewald and Ali taught in ring homologous compounds of Bondinell that the 2-substitution or 3-substitution of the central ring would not affect the biological activity.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

One having ordinary skill in the art would consider the instantly claimed position isomers of Bondinell prima facie obvious **because** position isomerism has been used as a tool to obtain new and useful drugs and position isomerism is a fact of close structural similarity. See exparte Engelhardt 208 USPQ 343, In re Mehta 146 USPQ 284. In the instant case not only one skilled in the art would be motivated to choose a position isomer in view of the known teaching in the field. One skill in the GABA inhibitor art is deemed to be aware of all pertinent art in the field. Sonnewald and Ali disclosed the ring homologous compounds of Bondinell and taught that substitution at 2-position on the ring carbon and 3-position on the ring carbon would be expected to having similar GABA inhibiting activity. Thus one skill would be motivated to employ the prima facie structural variation of position isomerism in modifying Bondinell since one would have reasonable expectation that such isomerism would give compounds with similar activity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (703) 305-0116. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

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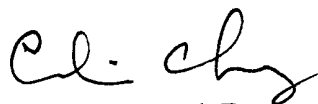
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Joseph Mckane, can be reached at (703) 308-4532. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592. When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mcKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

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August 8, 2002